REMARKS

Reconsideration and allowance of the subject application are respectfully requested.

The Examiner alleges that Applicant has acquiesced with respect to the prior assertion of "Official Notice" regarding certain dependent claim features. This is not the case; nor would such an allegation be appropriate or fair. First, those claim features have not been and are not now admitted to be prior art. Second, as MPEP §2144.03 makes clear, it is not "appropriate for the Examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well-known are not capable of instant and unquestionable demonstration as being well-known. For example, assertion of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art." *ID* at 2100-132. In this case, the specific acknowledgement by the claimed mediating trusted agent which includes a current exchange rate as well as the claimed customer account manager forwarding that exchange rate to the customer agent is not the kind of technical feature in this specific technical area of electronic payment systems suitable for Official Notice.

The last amendment was not intended to be directed to the Examiner's Official Notice positions in the dependent claims. Rather, after the interview conducted with the Examiner in the summer of 2004, where the Examiner suggested that the independent claims be amended to recite some interrelationship between the message content and an action taken in the method or by the machine, Applicant made such amendments to those independent claims following the Examiner's suggestions. Since the Examiner has made a new ground of rejection of all claims, and since Applicant has filed a Request for Continued Examination, Applicant is traversing this new ground of rejection and is also challenging the Examiner's assertions of Official Notice.

Claims 9 and 21, like claims 8 and 20, are in the context of particularly claimed electronic payment system/method. They relate to the claimed customer account manager including a voucher for the customer as part of the amended and forwarded initiation message to the claimed mediating trusted agent. This specific information exchange between the claimed customer account manager and mediating trusted agent is simply not suitable for Official Notice absent some documentary teaching in the **claimed context**.

Claims 1-23, 28, and 29 stand rejected under 35 U.S.C. §103 as being unpatentable over previously-applied Rosen in view of newly-applied U.S. Patent 6,223,291 to Puhl in view of newly-cited and applied U.S. Patent 6,047,270 to Joao. This rejection is respectfully traversed.

The Examiner simply re-states the rejection based on Rosen without identifying the particular elements by reference number from Rosen which correspond to each element of the rejected claims. In the prior response on pages 11, 12, and 13, Applicant gave specific examples why simply referring to a figure and "associated text" was insufficient to identify a particular element in such a figure that allegedly corresponded to each element of independent claim 1. To ensure that there is no ambiguity in the Examiner's position and no misunderstanding by Applicant, Applicant again requests that the Examiner identify a reference number used in Rosen for each claim element. For example, if the Examiner is contending that Rosen's merchant trusted agent 4 corresponds to the claimed merchant agent in claim 1, that would be very helpful to permit Applicant to understand the basis for the Examiner's rejection.

The Examiner admits that Rosen "does not disclose the use of a trusted intermediary, registration, and an account manager." The Examiner refers to "at least column 10, lines 8+ as well as other associated text" in Puhl as allegedly teaching these features missing in Rosen. Again, Applicant requests that the Examiner specifically identify the element in Puhl by number

that the Examiner contends corresponds to the claimed trusted intermediary. Column 10, line 8 simply provides definitions of several terms, such as a "security domain" and "attribute." Then, Puhl lists several "possible WAP domains." Although "trusted third party domains" are mentioned in the list, it is not clear what specific entity (again a reference number is needed) in Puhl's embodiment corresponds to such a trusted third party domain. Nor does the Examiner point out where Puhl discloses a specific trusted third party domain receiving from a customer account manager and amended initiation message along with the claimed account data so that the mediating trusted agent can register the customer. The Examiner also fails to demonstrate where Puhl's trusted third party domain receiving a deposit from the claimed customer account manager and then "sending an information message including said deposit to said merchant agent."

The Examiner concludes that it would be obvious to "combine Rosen's payment system with Puhl's trusted intermediary because this provides a higher level of protection and security to protect against fraudulent conduct." Where do either Rosen or Puhl make such a suggestion? The Examiner fails to demonstrate where that motivation comes "from the prior art" as the Federal Circuit requires. See, for example, *In Re Rouffet*, 149 F.3d 1350, 1357-38 (Fed. Cir. 1998).

A proper motivation to combine also requires an appreciation of the desirability of making the combination—not simply the feasibility of making the combination. See *Winner Int'l Royalty v. Wang*, 202 F.3d 1340, 1349 (Fed. Cir. 2000). In this case, there is evidence that the combination is not desirable coupled with an explicit teaching in Rosen that an intermediary, such as that described in Mao, should not be used. Indeed, the primary object of the invention in Rosen, (column 2, lines 16-18), states that:

> It is an object of the present invention to provide a secure system using trusted agents that enables electronic commercial payments from payer to payee *without any intermediaries*. (Emphasis added).

Accordingly, Rosen clearly *teaches away* from the combination proposed by the Examiner. The Federal Circuit has stated that a proposed modification that renders the prior art in operable for its intended purpose is inappropriate for an obviousness inquiry. *In re Fritch, 972 F.2d 1260, 1265-1266 (Fed. Cir. 1992).* The Examiner's modification of Rosen using Publ's intermediary renders Rosen inoperable to meet Rosen's intended objectives. Thus, the attempted combination is improper and must be withdrawn.

Applicant previously pointed out the fact that Rosen explicitly teaches away from the kind of combination the Examiner is again proposing now with Puhl. This deficiency was not addressed by the Examiner.

The Examiner admits that the improper combination of Rosen and Puhl "does not disclose "said customer account manager processing the initiation message, and in response to receiving an initiation message, providing said customer agent with account data during a trading session being established between said customer agent and said merchant agent over the network." So the Examiner turns to a third reference, Joao, and makes reference to "at least column 31+" as teaching "processing trades." But as the text just quoted above from claim 1 makes clear, the claim does not simply relate to "processing trades." The Examiner is requested to specifically identify the text in column 31, which relates to a brokerage transaction device 202 for trading securities such as stocks, bonds, futures, auctions, etc., that describes the claimed customer account manager which processes an initiation message that relates to "checking

purchases made by a customer from the merchant." It is unclear how a brokerage account manager describes this particular feature.

The Examiner contends that it would have been obvious to combine both Rosen and Puhl with Joao "because both systems refer to known best practices of secure electronic transactions." First, this is not a motivation to combine these three references in order to teach the rejected claims. Second, what is being modified in Rosen and what is being modified in Puhl with Joao's "processing trades?" Third, what are the "known best practices" to which the Examiner generally refers to? Which "best practice" described in Joao is the Examiner is relying on? How is such a "best practice" of Joao being used to modify Rosen and Puhl? Why?

On page 5, the Examiner notes two additional limitations lacking from Rosen and Puhl offset with bullets. The Examiner refers to column 6, lines 46+ in Joao as teaching stopping the transaction if the credit limit has been reached or exceeded. Even if this is the case, it does not correspond to what is claimed. The claimed relates to a deposit that it actually been delivered by a customer account manager to the claimed mediating trust agent on behalf of the customer agent. A credit limit is not a deposit.

Even if the combination of Rosen, Puhl, and Joao could be made for purposes of argument, multiple features are still lacking from this proposed combination. In addition, there is no reasonable motivation that stems from the prior art (independent from the claimed invention) for combining Rosen, Puhl, and Joao as the Examiner proposes. Indeed, in some instances, the Examiner has not even set forth how they would be combined or the reasons why. Moreover, the teaching away by Rosen with respect to the proposed combination with Puhl renders the combination untenable.

The application is in condition for allowance. An early notice to that effect is earnestly solicited.

Respectfully submitted,

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